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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,010	05/23/2001	Clay T. Whitehead	3813-3	7263

7590 08/25/2004

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,010

Applicant(s)

WHITEHEAD, CLAY T.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13 and 21-22, drawn to a method compiling a user profile relating to desired consumer items and using the consumer profile to identify relevant items from a database, classified in class 705, subclass 26.
 - II. Claims 14-20, drawn to a method maintaining a database of items available from product and service providers, classified in class 705, subclass 26.
2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as maintaining a database of items available from product and service providers and invention I does not require this. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have recognized divergent subject matter and for the reasons that search required for Invention II is not required for Invention I, restriction for examination purposes as indicated is proper.
4. A telephone interview was held with attorney Mr. Allan Kegan on August 11, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. **SPECIES**

This application contains claims directed to the following patentably distinct species of the claimed invention.

In the event applicant elects Invention I above, he is further obligated to elect among the following species as follows:

species of claims 1, 2, directed to an embodiment wherein compiling a user profile is done by monitoring a pattern of consumer item use.

species of claims 1, 3, directed to an embodiment wherein compiling a user profile is done according to user-entered parameters.

species of claims 1, 4, directed to an embodiment for periodically repeating steps (b)-(d) of claim 1.

species of claims 1, 5, directed to an embodiment wherein the relevant items are identified based on a lowest cost consistent with the user profile.

species of claims 1, 6 directed to an embodiment of consolidated billing for the implemented relevant items.

species of claims 1, 7 directed to an embodiment of communicating in steps © and (d) via electronic mail.

species of claims 1, 8 directed to an embodiment wherein consumer items comprising subscription services.

species of claims 1, 9 directed to an embodiment practicing on a one –time basis to effect a purchase of a particular product.

species of claims 1, 10 directed to an embodiment effecting a change of service from one vendor to another.

species of claims 1, 11 directed to an embodiment practicing to effect a sale of one product and purchase of a replacement product.

species of claims 1, 12 directed to an embodiment identifying related items separately and in combinations that are available at low incremental cost.

species of claims 1, 13 directed to an embodiment comprising informing the user if one or more parameters in the user profile significantly affects costs.

In the event applicant elects Invention II above, he is further obligated to elect among the following species as follows:

species of claims 14 and 15 directed to an embodiment for periodically repeating steps (b)-(d) of claim 14.

species of claims 14 and 16 directed to an embodiment wherein the relevant items are identified based on a lowest cost consistent with the user profile.

species of claims 14 and 17 directed to an embodiment of consolidated billing for the implemented relevant items.

species of claims 14 and 18 directed to an embodiment of communicating in steps © and (d) via electronic mail.

species of claims 14 and 19 directed to an embodiment wherein consumer items comprising subscription services.

species of claims 14 and 20 directed to an embodiment practicing on a one –time basis to effect a purchase of a particular product.

7. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic for Invention I and claim 14 is generic for Invention II.

8 Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

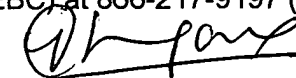
9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
August 11, 2004